

Attorney's Docket No.:10559/008001

REMARKS

In view of the foregoing amendments and the following remarks, reconsideration and allowance are requested.

Claims 1-5, 8-10, 12, 13, and 15-24 are pending. Claims 25-29 were subject to a restriction requirement and are now cancelled. No new matter has been added.

Claims 4, 5, and 8 stand rejected under 35 U.S.C. 102(e) in the Office Action for allegedly being anticipated by U.S. Patent No. 6,078,579 to Weingarten ("Weingarten").

Claims 1, 2, 9, 12-13 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Weingarten in view of U.S. Patent No. 5,222,136 to Rasmussen et al. ("Rasmussen"). Claims 10, 15-17 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Weingarten in view of U.S. Patent No. 6,603,857 to Batten-Carew et al. ("Batten Carew"). Claim 3 stands rejected under 103(a) for allegedly being unpatentable over Weingarten in view of U.S. Patent No. 6,434,378 to Fougnes ("Fougnes"). Claims 18, 19, 21, 23, and 24 stand rejected as being unpatentable over Weingarten in view of U.S. Patent No. 6,393,460 to Gruen et al. ("Gruen"). Claim 20 stands rejected as being unpatentable over Weingarten in view of Gruen and U.S. Patent No. 5,987,129 to Baba ("Baba").

35 U.S.C. 102 RejectionsClaim 4

Claim 4 is patentable over Weingarten because the prior art does not anticipate at least one feature of the claim. For example, Weingarten does not teach the feature of "using the network address that is sent over the *first network* to establish a network connection on the *second network*" (emphasis added). Instead, Weingarten teaches that a network address is sent over

Attorney's Docket No.:10559/008001

the second network to establish a network connection (Col. 8, lines 32-45 of Weingarten).

For example, Weingarten teaches that a first telephone 80 has a device 82 with a fax transmitting device that can send a fax to a second telephone 80 with a fax receiving device 82 (Col. 8, lines 32-45 of Weingarten). In Weingarten, the first communication network is the telephony network, and the second communication network is the Internet. The first telephone 80 has a microcontroller 84 that uses the IP address (of the fax receiving device 82) entered on the keypad of the first telephone 80 to use the Internet (the second network) to establish a connection to the second telephone 80. Weingarten says that "the owner of the first telephone 80 would enter the IP address ... on the first telephone's keypad and this would cause the microcontroller 84 to *establish a connection over the Internet* to the device 82" (emphasis added, Col. 8, lines 36-40 of Weingarten). Because Weingarten uses the second network to establish the network connection instead of having the first network to establish the network connection, Weingarten does not anticipate Claim 4.

Claim 4 is further patentable because Weingarten fails to anticipate "sending the encoded network address across the first network." As stated above, Weingarten has a special microcontroller to send the encoded network address across the *second network* (emphasis added, Col. 8, lines 36-40 of Weingarten). Hence, the 102(e) rejection to Claim 4 should be withdrawn.

Claim 4 is also patentable because Weingarten fails to teach that "the encoded network address is appended to telephone network signaling data." Weingarten is silent as to teaching the relationship between the encoded network address and the telephone signaling data (column 8, lines 36-40). Weingarten

Attorney's Docket No.:10559/008001

uses a special microcontroller and the second network to establish a network connection. The Applicants fail to see (1) where such an appending is taught, and (2) even if it is taught, then how the appending is taught with respect to the combination of features of Claim 4.

For at least the stated reasons above, Weingarten fails to anticipate all of the features of Claim 4. The Applicants respectfully request that the 35 U.S.C. 102(e) rejection to Claim 4 be removed, and Claim 4 be placed in condition for allowance.

Claim 5

Claim 5 is patentable because it depends upon an allowable base claim, Claim 1. Claim 1 is allowable because it has features that are similar to Claim 4. For instance, Claim 1 recites "using the network address that is sent over the first network to establish a network connection on the second network." Therefore, the Applicants request that the 102(e) rejection to Claim 5 be removed, and Claim 5 be placed in condition for allowance.

Claim 8

Claim 8 recites features that are similar to Claim 4, and is therefore patentable for at least with same stated reasons above with respect to Claim 4. For instance, Claim 8 recites "using the network address that is sent over the first network to establish a network connection on the second network." The Applicants respectfully request allowance of Claim 8.

35 U.S.C. 103(a) Rejections

Claim 1

Claim 1 is patentable because the cited prior art does not teach or suggest the combination of all of the features of the claim to those of ordinary skill in the art. For example, the

Attorney's Docket No.:10559/008001

suggested combined teaching of Weingarten and Rasmussen fails to teach or suggest the feature of "using the network address that is sent over the first network to establish a network connection on the second network." The Office Action states that column 8 lines 36-40 of Weingarten teaches this feature. However, the Applicants have shown with respect to Claim 4 that Weingarten uses the second network connection (e.g., the Internet) to establish that network connection via a microcontroller 84 in the first telephone 80 ("the microcontroller 84 to **establish a connection over the Internet to the device 82**" emphasis added, Col. 8 lines 36-40). Rasmussen, in teaching an encryption system, fails to remedy the deficiencies of Weingarten.

Therefore, for at least the reasons above, Claim 1 is patentable over Weingarten and Rasmussen, alone or in combination. The Applicants respectfully ask that Claim 1 be allowed.

Claims 9, 12-13

Claims 9, 12-13 recite features that are similar to Claim 1, and are therefore patentable for at least with same stated reasons above with respect to Claim 1. For instance, Claim 9 recites "using the network address that is sent over the first network to establish a network connection on the second network." The Applicants respectfully request allowance of Claims 9, 12-13.

Claim 10

The amended Claim 10 is patentable because the cited prior art does not teach or suggest the combination of all of the features of the claim to those of ordinary skill in the art. For example, the suggested combined teaching of Weingarten and Batten-Carew fails to teach or suggest the feature of "using the network address that is sent over the first network to establish a network connection on the second network." Claim 10 is

Attorney's Docket No.:10559/008001

allowable for at least the same reasons as stated above with respect to Claims 1 and 4. In teaching the transmission of an encryption key (Abstract, and Fig. 1 box 14, col. 2 line 65 to col. 3 line 3), Batten-Carew fails to remedy the deficiencies of Weingarten. Therefore, the Applicants respectfully request allowance of Claim 10.

Claims 15-16

Claim 17 is patentable because Weingarten and Batten-Carew fail to teach the feature to "transmit the encrypted audio signal across a voice communication network using a second connection between the first party and the second party." As noted in the Office Action, Weingarten fails to teach an encryption key. Batten-Carew fails to remedy all of the features of Claim 17 because Batten-Carew fails to first teach the feature to "encrypt an audio signal using the encryption key." Batten-Carew is silent towards the teaching of encrypting an audio signal using the encryption key. Therefore, Claim 17 should be allowed.

Weingarten fails to provide motivation for the hypothetical audio encryption feature in the Office Action (page 8, paragraph 3). A 35 U.S.C. 103 claim rejection requires a showing of a motivation in the prior art that supports the combination of features from the prior art references. The Applicants contend that Claim 17 is patentable over the combination of Weingarten and Batten-Carew because there is no motivation to modify Weingarten to include the feature of "transmit the encrypted audio signal across a voice communication network using a second connection between the first party and the second party," as recited in Claim 17. Because Weingarten doesn't even suggest an encryption key, and Batten-Carew is silent towards the teaching of encrypting an audio signal using the encryption key then no motivation for a combination is provided.

Attorney's Docket No.:10559/008001

Claim 15 has features that are similar to Claim 17 and should be allowed for at least the same reasons as Claim 17. For instance, Claim 15 recites the feature of "transmitting the encrypted audio signal across the voice telephone network." Batten-Carew is silent on this feature in combination with the other features of Claim 15.

Claim 16 has features that are similar to Claim 10 that are not taught in the prior art. For example, the feature of "sending the encoded network address across the voice communication network; and using the encoded network address to establish a connection across the computer network" is not taught in the cited prior art. Claim 16 is also patentable for depending upon an allowable base claim, Claim 15. Therefore, the Applicants respectfully request the allowance of Claim 16.

For at least the stated reasons above, Claims 15-17 should be placed in condition for allowance.

Claim 3

Claim 3 recites features that are similar to Claim 4, and is therefore patentable for at least the same reasons stated above with respect to Claim 4. The Applicants respectfully request allowance of Claim 3.

Claims 18, 19, 21, 23 and 24

The amended Claim 18 recites a feature that is similar to Claim 4, and is therefore patentable for at least the same reasons stated above with respect to Claim 4. For example, Claim 18 recites the feature of "establishing a connection across a computer network between a calling computer and a receiving computer by using a computer network address sent on the voice communication network to establish the connection on the computer network." Weingarten and Gruen, alone or in combination, fail to teach or suggest this feature. For at

Attorney's Docket No.:10559/008001

least this reason alone, the Applicants request allowance of Claim 18.

Claim 18 is further patentable because the prior art fails to teach the verification feature. For example, Gruen mentions a chat session feature, such as an Instant Messenger (col. 4, lines 10-11). However, a chat feature does not verify the type of the connections. For instance, the sending and receiving telephones and the sending and receiving computers as described with respect to Claim 18 are not verified in relation to a type of network connection in Gruen. Instant messaging features are designed for computer-related applications with graphical user interfaces. Instant messaging does not verify the type of connection (e.g., voice communication network or a computer network). An instant message feature doesn't verify that the "receiving computer is coupled to the receiving telephone" across a voice communication network. Therefore, the hypothetical combination in the Office Action does not teach or suggest all of the features of Claim 18, and Claim 18 should be allowed.

Claims 19 and 21 are patentable for depending from an allowable base claim, Claim 18, and for reciting allowable subject matter in their own right.

Claims 23-24 recite features that are similar to Claim 18 (e.g., the verification feature). Because Claim 18 is an allowable base claim, Claims 23-24 are allowable as well. Proper allowance is respectfully requested.

Claim 20

Claim 20 recites features (e.g., the method of establishing the computer network) that are similar to Claim 4, and is therefore allowable for at least the same reasons.

Attorney's Docket No.:10559/008001


CONCLUSION

In view of the amendments and remarks, Applicants believe that all pending Claims, Claims 1-5, 8-10 12, 13, 15-24, are in condition for allowance and ask that those pending claims be allowed. The foregoing comments made with respect to the positions taken by the Examiner are not to be construed as acquiescence by the Applicants with other positions of the Examiner that have not been explicitly contested. Accordingly, Applicants' arguments for patentability of a claim should not be construed as implying that there are not other valid reasons for patentability of that claim or other claims.

Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 05/26/04


Dwight U. Thompson
Reg. No. 53,688

Fish & Richardson P.C.
PTO Customer Number: 20985
12390 El Camino Real
San Diego, CA 92130
Telephone: (858) 678-5070
Facsimile: (858) 678-5099
10374339.doc